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**FACSIMILE COVER LETTER**

**To:** Examiner Mary Mosher  
**Firm:** U.S. Patent and Trademark Office  
**Facsimile:** 571 273-8300  
**From:** Thomas J. Kowalski  
**Date:** November 21, 2005  
**Re:** U.S. Patent Application No. 08/228,926  
Modified Vaccinia Virus And Methods For Making And Using The Same  
Our Ref. No.: 674310-2430.1  
**Number of Pages:** 10  
(including cover page)  
**cc:**

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PATENT  
USSN 08/228,926  
Atty docket: 674310-2430.1**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants : Paoletti et al.  
Serial No. : 08/228,926  
Filed : April 18, 1994  
For : **MODIFIED VACCINIA VIRUS AND METHODS FOR  
MAKING AND USING THE SAME**  
Group Art Unit : 1648  
Examiner : M. Mosher

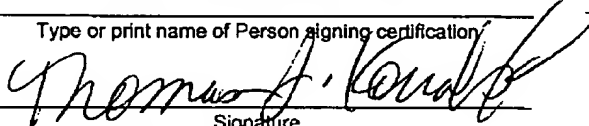
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**PETITION TO WITHDRAW TERMINAL DISCLAIMER**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**RELIEF REQUESTED**

It is hereby respectfully requested that the Terminal Disclaimer in this application  
be withdrawn.

**FACTS & ARGUMENT**

This application has returned to prosecution, after its prosecution was  
suspended during Interference No. 103,399 and the subsequent prosecution of the  
Senior Party's applications.

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Prior to the suspension of prosecution, there was a final Office Action wherein claims 48 and 49 were rejected for obviousness-type double patenting in view of claim 7 of US Patent No. 4,603,112. A Terminal Disclaimer was filed to expedite prosecution. This application was then placed into the already ongoing Interference, No. 103,399, with the prosecution of this application then suspended.

By a concurrently-filed Amendment, the claims now pending are:

33. (Previously presented) A plasmid comprising donor DNA not naturally occurring in vaccinia virus encoding a peptide foreign to vaccinia virus, said donor DNA present within a non-essential region of a segment of vaccinia virus DNA otherwise co-linear with portions of the vaccinia virus genome such that DNA from a non-essential region of vaccinia virus is flanking said donor DNA, and whereby when incorporated into vaccinia virus by in vivo recombination expression of the donor DNA is under vaccinia control.
34. (Previously presented) The plasmid of claim 33 wherein the donor DNA comprises a herpes simplex virus TK gene.
35. (Previously presented) The plasmid of claim 33 wherein the segment of vaccinia virus DNA otherwise co-linear with portions of the vaccinia virus genome is the HindIII F-fragment of the vaccinia virus genome.
36. (Previously presented) The plasmid of claim 35 wherein for expression there is a promoter within the F-fragment.
37. (Previously presented) The plasmid of claim 36 wherein the donor DNA comprises a BamHI TK gene of herpes simplex virus.
38. (Previously presented) The plasmid of claim 34 wherein the segment of vaccinia virus DNA otherwise co-linear with portions of the vaccinia virus genome is the Aval H-fragment of the vaccinia virus

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genome.

39. (Previously presented) The plasmid of claim 35 which is pDP137.

40. (Previously presented) The plasmid of claim 38 which is pdP202TK/E.

52. (New) Donor DNA comprising isolated DNA not naturally occurring in poxvirus flanked by DNA sequences homologous with portions of a non-essential region of the poxvirus genome.

53. (New) Donor DNA comprising isolated DNA not naturally occurring in vaccinia virus flanked by DNA sequences homologous with portions of a non-essential region of the vaccinia genome.

That is, by a concurrently-filed Amendment, the claims that were the subject of the double patenting rejection are no longer pending.

The above claims are patentably distinct from the claims of any issued Paoletti patent and any pending Paoletti patent application, and thus avoid double patenting as to any issued Paoletti patent and any pending Paoletti patent application, including the Paoletti patent(s) and/or application(s) that is (are) the subject of the previous double patenting rejection as to which the Terminal Disclaimer was earlier filed in the prosecution.

Indeed, it is specifically noted that only claims 48 and 49 (directed to recombinant vaccinia virus vP2, vP4, vP6 and vP22) were subject to a double patenting rejection as to claim 7 of US Patent No. 4,603,112; that to obviate only that double patenting rejection, a Terminal Disclaimer was filed; and, that by the amendments herewith the presently pending claims and claims herewith are not to recombinant vaccinia virus and are not dependent upon a recombinant vaccinia virus claim, out of an abundance of caution to avoid any double patenting issues that may extend beyond the original rejection of claims 48 and 49.

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**CONCLUSION**

Withdrawal of the Terminal Disclaimer is respectfully requested.

Any fee required for this Petition or for the withdrawal of the Terminal Disclaimer, may be charged, and any overpayment credited, to Deposit Account No. 50-0320. If there is any impediment to withdrawal of the Terminal Disclaimer and allowance of the application, an interview is respectfully requested, with the Examiner respectfully requested to telephonically contact the undersigned to arrange a mutually convenient time and manner therefor.

Respectfully submitted,  
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